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IN THE

Supreme Court of the United States

OCTOBER TERM, 1948

No. 246

ALLEN-BRADLEY COMPANY,
Petitioner,

vs.

SQUARE D COMPANY,
Respondent.

REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

CARLTON HILL,
SAMUEL W. KIPNIS,
53 West Jackson Blvd.,
Chicago, Illinois
Attorneys for Petitioner

VICTOR S. BEAM,
LOUIS QUARLES,
Of Counsel for Petitioner.

Oct. 13, 1948.

HANNERSMITH-KORTHEYER CO. MILWAUKEE

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Apparently respondent concedes that in case of conflict of opinion between different benches of a Court of Appeals it is the province of this Court to decide the issue to the end that the law of the circuit may be definite and uniform for in its brief it avoids the issue.

It contents itself with a discussion to the effect that there is no inconsistency and confusion in the Court of Appeals for the Seventh Circuit. On this issue it fails utterly as will shortly be shown.

Respondent claims that there is no issue of public importance raised and no novel principle of patent law involved. Firstly, there is the issue of what the law as to invention is in the Seventh Circuit and likewise in the United States in view of the decisions in other circuits and in view of the fact that a petition for a writ of certiorari in the case of *National Slug Rejectors, Inc.* vs

A.B.T. Mfg. Corp. 164F2D333, was twice denied by this Court, 333 U.S. 832, 68 S.C. 459, 333 U.S. 850, 68 S.C. 658, and Secondly, there is the novel issue of patent law involved; viz., is novelty and utility of prime importance in determining presence of invention?

Respondent does not contest the proposition that the three phase switch of the Wilms and Petersen patent in suit has utility, as it could not in view of the record, which shows that the principle and construction of that switch more than doubled the size or capacity of the motor which it could control (P. Ex. 83, R. pp. 581, 1385), but contents itself with attacking the novelty of the switch. On this point Respondent confuses actual novelty with inventive novelty which latter the Court of Appeals had in mind in deciding the instant case. As to actual novelty, Respondent in deprecating the improvement made in the Wilms and Petersen switch has reiterated that the only change made over the Wilms and Dawe switch was the placing of a bottom wall in the hood and the District Court in finding 29 (R. p. 105), quoted by the Court of Appeals held that: "Adding the bottom wall to the Wilms and Dawe switch, to enclose completely the contacts except for a single opening in the bottom wall through which the actuator passes, is a mere mechanical device", etc. The Court of Appeals even stated that, "the question arises as to whether the means employed to obtain the *improved result* — the enclosure of the hood at the bottom—was of such an ingenious nature as to amount to invention." (R. p. 2562) (emphasis added). Surely it is clear from the above that there was actual novelty in the Wilms and Petersen switch. And the Court of Appeals clearly differentiates this from inventive novelty which it would not accord to Wilms and Petersen contrary to the law as laid down by a different bench in the *slug* case.

Of course there are other differentiations between the Wilms and Petersen switch and the Wilms and Dawe switch such as the encasement of the contact springs which were specifically mentioned by the District Court (R. p. 101) and the Court of Appeals (R. pp. 2564-5) and, aside from their presence showing actual novelty, this accentuates the difference in principle of operation between Wilms and Petersen and Wilms and Dawe, since the encasements became necessary to protect the springs against the arcs when the arcs are impounded in Wilms and Petersen as differentiated from being dispersed into the surrounding air in Wilms and Dawe according to the age old dispersed arc principle.

Coming now to the question of conflict between the decisions of one bench in the *slug* case and of another bench in the instant case, we have shown that in the instant case the Court of Appeals held that even though there was actual novelty and utility in Wilms and Petersen it would not accord invention to these inventors even though their switch had met with surprising commercial success (R. p. 357). We have also shown the importance attributed to actual novelty and utility in the *slug* case. Respondent however states:

> "The patent in the *National* [*slug*] case was sustained, not only because the device was *new* and useful but because in view of the prior art and the other facts in the case, the Court was persuaded that the prerequisite of patentability, i.e. inventiveness, was also present." (emphasis copied) (Res. brief p. 8).

This statement is directly in contradiction of the statements of the *slug* opinion. The opinion in the *slug* case quotes the law with emphasis as showing that *"any new and useful art"* may be the subject of a patent and immediately states thereafter that: "The statute exacts no-

thing more." The opinion then states that the Courts "have long if not always, required that there be something about the novelty which makes the 'new' in the mechanism something to cause the Court to say 'here an inventor labored' ". This latter is not "a first prerequisite". Novelty and utility are the first prerequisites of invention.

But even assuming that novelty and utility were not of prime importance in the *slug* case opinion, the opinion is still at variance with the holding in the instant case, for there is not closer prior art in the instant case than Wilms and Dawe. It is also shown that physically something had to be added to that and the record shows that the Wilms and Petersen switch met with surprising commercial success (R. p. 357). Thus we have a parallel to the *slug* case as to actual novelty and utility and yet different benches decided the same question differently.

Respondent on page 2 of its brief states in effect that the courts below found that the Wilms and Petersen patent did not disclose a new combination having a novel principle and producing a new result but fails to state where this is set forth. There is no such statement by either Court and there could not be any such valid statement for there was a new combination with the bottom of the hood to cause an impounding of the arc which was a principle not found in any prior art switch structure as all of the prior comparable switch structures operated on the old arc dispersal principle and a new result was the producing of a switch which would control a larger motor (P. Ex. 83, R. pp. 581, 1385).

Respondent undertakes to restate on pages 2, 3 and 4 of its brief the construction of the Wilms and Petersen switch but all that it does is to recite non-essential details of construction of the figures of the patent and omits

fundamental characteristics such as that the switch is of the three phase type and that it provides pockets or ends for impounding of the arcs. Even the District Court regarded the switch as a three pole affair (R. p. 54) and the Court of Appeals recognized it as a three phase structure wherein flashover between phases is a feature to be guarded against (R. pp. 2554-5). Respondent even likens the patent structure to the Wilms and Dawe structure because in both the arcs are driven against the side walls of the hood for cooling but neglects to point out that the arcs are compressed into the ends of the hood and are not dispersed into the air as in the Wilms and Dawe structure.

Respondent attempts to make much of the findings of fact by the District Court but these viewed in the light of the decision of the Court of Appeals are properly relegated to the class of unimportant and inconsequential details. The only finding material to the issue decided by the Court of Appeals is No. 29 (R. p. 105), which is really a conclusion of law, and which sets forth the fact that a part — the bottom plate — was added to Wilms and Dawe making a new combination and producing a new result. The only real and material concurrence between the District Court and the Court of Appeals is in holding that the new and useful features of Wilms and Petersen did not entitle them to the status of inventors — contrary to the rule in the *slug* case.

As shown in our prior brief, theory of operation is not important and lack of theory or a wrong theory does not militate against the validity of a patent of a workable structure.

As the parties and the Court of Appeals are in practical agreement upon the impounding of the arc by reason of

the fact that the lower wall of the hood encloses the contacts and bar and this is recited in the claims, there is no basis for the charge of indefiniteness of the claims in suit.

Likewise there is no basis for the charge that new matter was introduced by the amendment to the Wilms and Petersen application of October 10, 1936, when claims 21 to 24 and 26 in suit were made, for claims 2 and 20 were made prior to that time and before respondent purchased the Allen-Bradley switch PX-44 to design its switch PX-2 (R. p. 1268) and were allowed April 25, 1936, before Respondent's switch PX-2 was placed on the market. Claim 20, made February 1936, is broader than claims 21 to 24 and 26 in suit and combines double break contacts arranged in a closed chamber at each pole, a carrier having a spring contact holder passing into each chamber through an opening, and a spring shield movable with the contact holder and substantially closing the opening into the hood. Claim 2 *in the original application* is even broader than claim 20, as it specifies merely contacts, instead of double break contacts, in the same combination as in claim 20.

Moreover, Respondent cannot claim immunity from infringement of the patent by reason of the prosecution of the application, as it did not have any knowledge of the invention described and claimed, save the Allen-Bradley switch PX-44, from which it made its copied infringement of the patent issued on the application.

CONCLUSION

For the reasons stated the writ should be allowed.

CARLTON HILL

SAMUEL W. KIPNIS

53 West Jackson Blvd.
Chicago, Illinois
Attorneys for Petitioner.

VICTOR S. BEAM

LOUIS QUARLES

Of Counsel for
Petitioner

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